



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,442	11/21/2000	Brian Edmondson	J3508(C)	1978

201 7590 02/03/2003

UNILEVER
PATENT DEPARTMENT
45 RIVER ROAD
EDGEWATER, NJ 07020

EXAMINER

EASHOO, MARK

ART UNIT	PAPER NUMBER
----------	--------------

1732

8

DATE MAILED: 02/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-8

Office Action Summary

Application No.

09/717,442

Applicant(s)

EDMONDSON ET AL.

Examiner

Mark Eashoo, Ph.D.

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-31 is/are rejected.
- 7) ☒ Claim(s) 20-31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of claim 19 in Paper No. 7, filed 21-JAN-2003 is acknowledged. The traversal is on the ground(s) that there is no undue burden on the Office. This is not found persuasive because the specific structural limitations of the product, claim 19, do not require a search of the specific step-wise limitations of the process, claims 1-14. Similarly, the specific structural limitations of the product, claim 19, do not require a search of the specific structural limitations of the apparatus for making the product, claims 15-18.

The requirement is still deemed proper and is therefore made FINAL.

Information Disclosure Statement

The information disclosure statement filed 21-JAN-2003 complies with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. Accordingly, it has been placed in the application file and the information referred to therein has been considered as to the merits.

The above mentioned IDS has a certificate of mailing dated 17-APR-2001 which was before the mailing of the first Office action. Since this IDS was not filed or matched with the application in the Office until 21-JAN-2003, the examiner was not aware of the abstract for JP 60-106900. Although not applied because of duplicity (ie. repeating of the same rejection), the examiner gives notice that should the rejection below be overcome then the abstract and Fig. 1 of JP 60-106900 would serve as a basis for a rejection of claims 19-31, under 35 USC 102(b), as instantly claimed limitations for the same reasons as set forth below.

Claim Rejections

Claims 20-31 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Specifically, claim 19 recites a process of extrusion wherein the cross-section of a die varied during the process. As such, the instantly claimed product structure formed thereby is one that has a variable

Paper No. 8, FINAL - Art Unit: 1732

cross-sectional shape. However, claims 20-31 recite further process steps but these steps do not present any additional structure which clearly define the metes and bounds or any product structure beyond that set forth in claim 19.

Claim Rejections - 35 USC § 112

Claims 20-31 are rejected under 35 U.S.C. 112, forth paragraph, as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Specifically, claim 19 recites a process of extrusion wherein the cross-section of a die varied during the process. As such, the instantly claimed product structure formed thereby is one that has a variable cross-sectional shape. However, claims 20-31 recite further process steps but these steps do not present any additional structure which clearly define the metes and bounds or any product structure beyond that set forth in claim 19.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 19-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Slocum (US Pat. 5,834,410).

Slocum teaches a shaped detergent/soap bar having a cross-sectional area that varies along at least part of its length (Figs. 5, 6, and 11).

The Court of Appeals for the Federal Circuit, in *In re Thorpe*, 227 USPQ 964, held that determination of patentability in 'product-by-process' claims is based on the product itself, even though such claims are limited and defined by the process, and thus the product in such claim is unpatentable if it is the same as, or obvious from, the product of prior art, even if the prior product was made by a different process. (See MPEP § 2113.)

Claims 19-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Marek (US Pat. 4,746,452).

Marek teaches a shaped detergent/soap bar having a cross-sectional area that varies along at least part of its length (Figs. 1-4).

The Court of Appeals for the Federal Circuit, in *In re Thorpe*, 227 USPQ 964, held that determination of patentability in 'product-by-process' claims is based on the product itself, even though such claims are limited and defined by the process, and thus the product in such claim is unpatentable if it is the same as, or obvious from, the product of prior art, even if the prior product was made by a different process. (See MPEP § 2113.)

Response to Arguments

Applicant's arguments filed 23-JAN-2003 have been fully considered but they are not persuasive, because:

Applicant's alleges that the bar shape of Slocum and Marek is complex and therefore unable to be made by a variable die extrusion process. This is not persuasive because applicant's disclosure does not provide any teaching of the soap bar structure (ie. no figure or drawings are presented) other than a written description that the soap extrudate has a variable cross-sectional shape (instant specification pg. 3, li. 13-30). The soap/detergent bars of both Marek and Slocum teach a variable cross-sectional shape and as such reasonably appears to be either identical with or only slightly different than the product claimed by the instant product-by-process claims. Furthermore, applicant has not provided any evidence that the structure of Slocum and Marek can not be made by variable die extrusion but rather has only provided arguments making such allegation. It is noted that arguments of counsel cannot take the place of evidence in the record. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

The examiner cites Provost, Otte, Parise, and Brumlik as evidence that variable die extrusion can be used to form very complex shapes from moldable materials.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Paper No. 8, FINAL - Art Unit: 1732

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Eashoo, Ph.D. whose telephone number is (703) 308-3606. The examiner can normally be reached on 7am-3pm, Monday- Friday (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Silbaugh can be reached on (703) 308-3829. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Mark Eashoo, Ph.D.
Primary Examiner
Art Unit 1732

29/Jm/03

me
January 29, 2003